



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,301	06/03/2002	Peter Loser	18744-0005	9833
29052	7590	10/07/2003		
SUTHERLAND ASBILL & BRENNAN LLP 999 PEACHTREE STREET, N.E. ATLANTA, GA 30309				
			EXAMINER PRIEBE, SCOTT DAVID	
			ART UNIT 1632	PAPER NUMBER

DATE MAILED: 10/07/2003 //

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	10/049,301	LOSER ET AL.	
	Examiner	Art Unit	
	Scott D. Priebe	1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim 9 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim may not depend from a multiple dependent claim, e.g. claim 8, directly, and claim 7, through claim 8. See MPEP § 608.01(n). Accordingly, the claim 9 has not been further treated on the merits.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-8, 10-17, drawn to a method for transfer of genetic material to cells in culture using an ovine atadenoviral vector.

Group II, claim(s) 1-4, 6-8, 10-13, 14-17, drawn to a method for transfer of genetic material to cells in culture using an ovine mastadenoviral vector.

Group III, claim(s) 1-4, 6-8, 10-13, 14-17, drawn to a method for transfer of genetic material to cells in culture using a bovine atadenoviral vector.

Group IV, claim(s) 1-4, 6-8, 10-13, 14-17, drawn to a method for transfer of genetic material to cells in culture using a bovine mastadenoviral vector.

Group V, claim(s) 1, 2, 6-8, 10, 11, 15-17, drawn to a method for transfer of genetic material to cells in culture using a bird adenoviral vector.

Group VI, claim(s) 1-8, drawn to a method for transfer of genetic material to muscle or tumor cells in a mammal using an ovine atadenoviral vector.

Group VII, claim(s) 1-4, 6-8, drawn to a method for transfer of genetic material to muscle or tumor cells in a mammal using an ovine mastadenoviral vector.

Group VIII, claim(s) 1-4, 6-8, drawn to a method for transfer of genetic material to muscle or tumor cells in a mammal using a bovine atadenoviral vector.

Group IX, claim(s) 1-4, 6-8, drawn to a method for transfer of genetic material to muscle or tumor cells in a mammal using a bovine mastadenoviral vector.

Group X, claim(s) 1, 2, 6-8, drawn to a method for transfer of genetic material to muscle or tumor cells in a mammal using a bird adenoviral vector.

The inventions listed as Groups I-X do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Groups I-V and groups VI-X are directed to different methods requiring different products. Groups I-V are directed to the production of recombinant cells in culture, whereas Groups V-X are directed to transferring genetic material into a mammal. The only technical feature linking Groups I-V and VI-X is the use of a non-human adenoviral vector. Each of Groups I-V or VI-X involve use of adenoviral vectors based upon different non-human animal

Art Unit: 1632

hosts or different types of adenovirus. The only link between these inventions is that the vectors are non-human adenoviral vectors.

However, the use of non-human adenoviral vectors for transfer of genetic material either to cells in culture or into mammals is not a special technical feature. See for example: Haddada et al., US 6,294,377 (PTO-892, 3/18/03); and Mittal et al., US 5,820,868; Both, G.W. WO 97/06826; Both et al., WO 96/03508; Hofmann et al.; J. Virol. 73 (8): 6930-6936; *inter alia* (PTO-1449, 4/5/02); and the International Preliminary Examination Report filed with the instant application.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

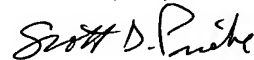
The drawings were received on 7/15/03. These drawings are unacceptable for the reasons set forth on the attached PTO-948. New formal drawings are required in this application. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to this Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Art Unit: 1632

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott D. Priebe whose telephone number is (703) 308-7310. The examiner can normally be reached on M-F, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds can be reached on 703 305-4051. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Scott D. Priebe
Primary Examiner
Art Unit 1632